

Summary of Personal Interview with the Examiner

On May 13, 2005, Examiner Feely and the Applicants' Representative, Mr. Andrew Merriam, conducted a personal interview to further prosecution in the instant application.

During the interview, Mr. Merriam pointed out that the obviousness type double patenting rejections of any of the instant claims 58-62 over any claims of related U.S. Patent nos. 6,346,292 B1 or 6,677,032 B1 that recite core-shell tougheners are improper because those patents are related to the instant application and, further, those patents represent a group of claims (drawn to core-shell copolymer toughened coating powder) restricted out from the group of the instant claims 1-3, 5-6, 8-16 and 58-62 (drawn to adduct toughened coating powder and polyhydroxyl crosslinker toughened coating powder). 35 U.S.C. 121. Further, the core-shell toughened group of claims was restricted out from the subject matter of the instant claims in the grandparent of the instant application. See the restriction requirement of U.S. Application Serial No. 09/173,146, mailed on March 03, 2000, at paragraph 6, wherein the Patent Office required a species election between the core-shell polymer, the polyhydroxyl functional crosslinker and the elastomer "adduct". Still further, and contrary to the position taken in the rejection, "adducts" were included in the originally filed claims 1-17 of grandparent U.S. Application Serial No. 09/173,146. The originally filed claims 1-17 of grandparent U.S. Application Serial No. 09/173,146 recited "a resin" comprising an elastomer component and an epoxy component; thus, "a resin", as claimed in the grandparent application, included both mixtures and resinous reaction products of epoxy and elastomer, such as adducts. In fact, the adduct was the form of the recited resin actually disclosed in the grandparent specification. See the grandparent specification 09/173,476 and the instant specification at, for example, page 3, lines 1-7 and page 6, line 20 to page 7, line 6.

In addition, Mr. Merriam observed, obviousness type double patenting rejection of instant claims 58-62 over claims 1, 6, 9, 13 and 16 of related case U.S. Patent no. 6,346,292 B1 is improper in any case because the instantly recited "adduct" would not comprise the core-shell copolymer of related U.S. Patent no. 6,346,292 B1. The instantly recited adduct retains microdomains of epoxy and elastomer in the product coating. See the instant specification at, for example, page 6, line 20 to page 7, line 6 and U.S. Patent no. 6,346,292 B1, to Grubb et al., at col. 4, lines 28-49. In fact, the

chemical bond between the instantly recited epoxy resin and the instantly recited elastomer of the instantly recited adduct ensures that phase separation does not occur during processing. In contrast, a core-shell copolymer embodies epoxy encapsulated rubbery polymer. U.S. Patent no. 6,346,292 B1, to Grubb et al., at col. 2, lines 15-26. Accordingly, the instantly recited adduct forms no core-shell copolymer and the instant claims are not obvious in view of the claims of related U.S. Patent no. 6,346,292 B1.

Regarding the obviousness type double patenting rejections of some of the instant claims over related U.S. Patent no. 6,677,032, Mr. Merriam acknowledged that the terminal disclaimer, filed on January 17, 2005, failed to identify the patent being disclaimed. The Applicants would be willing to file a proper terminal disclaimer to obviate this rejection.

Regarding the rejection of instant claims 1-3, 5-6, 58 and 60 over Savin, U.S. Patent no. 5,677,367 under 35 USC 102(b), Mr. Merriam pointed out that Savin fails to disclose coatings on high tensile steel or methods for coating high tensile steel. See Savin at column 11, lines 50-59 and at column 13, lines 7-8. Further, Mr. Merriam pointed out that the Example cited in the rejection, Savin's Example 1, refers to a coating suspended in solvent and not a powder coating. See column 17, lines 53-55 and column 18, lines 20-30. Accordingly, the anticipation rejections over Savin are improper.

In addition, Mr. Merriam explained that it would not be obvious in view of Savin to make the instantly recited coatings. Savin teaches away from use of coating powders having more than 100 phr (parts per hundred resin) of zinc on any substrate for corrosion protection. See column 10, lines 3-16, especially lines 9-13. Thus, it would be unobvious in view of Savin to coat any substrate with any powder having the instantly recited 150 or more phr of zinc, and thereby provide corrosion protection. Unlike in Savin, the instantly recited powder coatings provide corrosion and chip resistance. See the instant specification at, for example, page 1, lines 2-4 and 19-23, page 4, lines 2-7, and page 8, lines 3-8. Thus, while Savin's Example 13 refers to a powder coating, however it does not refer to not one that is coated on the instantly recited high tensile steel and could not render any of the instant claims obvious because such a coating could not be expected to work if used for corrosion protection. See column 10, lines 3-16 of Savin.

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The Examiner agreed to reconsider the outstanding rejections in view of Applicants' comments. The Applicants wish to thank the Examiner for extending the courtesy of a personal interview.

REMARKS

Support for the amendments to the claims

The present amendment to claim 1 seeks solely to better define the instantly recited coatings by pointing out that such coatings exhibit corrosion resistance, as well as chip resistance. Support for this amendment may be found, for example, in the instant specification at page 1, lines 2-8 and 19-23, page 4, lines 2-7, and page 8, lines 3-8.

Upon entry of the present amendment, claims 1-3, 5-6, 8-16 and 58-62 stand pending in the instant application. No new matter is added by the present amendment.

Claim Rejections Under 35 USC 102

Claims 1-3, 5-6, 58 and 60 stand rejected under 35 USC section 102(b) as being anticipated by Savin, U.S. Patent no. 5677367, of record. The applicants respectfully traverse this rejection.

Savin fails to recite high tensile steel substrates or any method of coating them. See the Summary of Personal Interview with the Examiner, above.

Regarding claims 3 and 6, the rejection is not understood because the rejected claims recite only elastomer adducts which are not disclosed, taught or suggested in the art. The recitation of claims 3 and 6 is understood to modify the recited resin adduct I(ii) of claim 1, not the polyhydroxyl crosslinker and epoxy resin I(i) of claim 1. Under the statutory requirement for claim differentiation, the rejected claims 3 and 6 cannot reasonably be interpreted to include coatings made from the polyhydroxyl crosslinker and epoxy resin I(i) of claim 1. 35 USC section 112, 4th paragraph. If the law were otherwise, then an interpretation of claims 3 and 6 as including the resin I(i) would thereby result in a reading of those claims as having the *exact same scope* as that of claim 1! Such a result is impermissible. The Applicants respectfully request the Examiner to reconsider these rejections and, if necessary, to consult a respected colleague for confirmation.

The rejections are improper. Applicants respectfully request the withdrawal of all rejections over Savin.

Obviousness-Type Double Patenting

Claims 1, 4, 5-6, 58 and 60 stand rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over claims 1, 3 and 6 of U.S. Patent no. 6,677,032, to Grubb et al. Applicants respectfully traverse this rejection.

The core shell resin recited in claims 1, 3 and 6 of Grubb et al. was restricted from and cannot be cited against the elastomer "adduct" claimed in the instant application. 35 U.S.C. § 121. Further, the instantly recited adduct is not a core-shell resin and the instantly recited "adduct" toughener was in fact included in the scope of the original claims 1 to 17 that restricted out from core-shell tougheners. See the Summary of Personal Interview with the Examiner, above. See also the restriction requirement of U.S. Application Serial No. 09/173,146, mailed on March 03, 2000, at paragraph 6, wherein the Patent Office required a species election between the core-shell polymer, the polyhydroxyl functional crosslinker and the elastomer "adduct". Further, each of U.S. Application Serial No. 09/703,408, which became U.S. Patent no. 6,677,032, and the instant application were filed as a result of such restriction requirement; and both applications were required to cover the different species examined. The Applicants respectfully request the reconsideration and the withdrawal of these rejections.

Claims 8, 10-16, 59 and 61-62 stand rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over claims 7, 9-14 and 16-20 of U.S. Patent no. 6,677,032, to Grubb et al. Applicants respectfully traverse this rejection.

With respect to claims 7, 9-14 and 16-17, the rejection is improper. The core shell resin recited in claims 7, 9-14 and 16-17 of Grubb et al. was restricted from and cannot be cited against the elastomer "adduct" claimed in the instant application. 35 U.S.C. § 121. Further, the instantly recited adduct is not a core-shell resin and the instantly recited "adduct" toughener was in fact included in the scope of the original claims 1 to 17 that restricted out from core-shell tougheners. See the Summary of Personal Interview with the Examiner, above. See the restriction requirement of U.S. Application Serial No. 09/173,146, mailed on March 03, 2000, at paragraph 6, wherein the Patent Office required a species election between the core-shell polymer, the

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polyhydroxyl functional crosslinker and the elastomer "adduct". Further, each of U.S. Application Serial No. 09/703,408, which became U.S. Patent no. 6,677,032, and the instant application were filed as a result of such restriction requirement; and both applications were required to cover the different species examined.

The Applicants respectfully request the reconsideration and the withdrawal of these rejections.

With respect to claims 18-20 of U.S. Patent no. 6,677,032, the elimination of the second coating layer with retention of the chip resistant coating properties is evidence of unobviousness. Nevertheless, without acceding to the correctness of the Examiner's position, the Applicants have submitted a terminal disclaimer to obviate the obviousness-type double patenting rejection in view of U.S. Patent no. 6,677,032. Accordingly, Applicants respectfully request the withdrawal of all obviousness-type double patenting rejection in view of U.S. Patent no. 6,677,032.

Claims 58-62 stand rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over claims 1, 6, 9, 13 and 16 of U.S. Patent no. 6,346,292, to Grubb et al. Applicants respectfully traverse this rejection.

The rejection is improper. The core shell resin recited in claims 1, 6, 9, 13 and 16 of U.S. Patent no. 6,346,292 was restricted from and cannot be cited against the elastomer "adduct" claimed in the instant application. 35 U.S.C. § 121. Further, the instantly recited adduct is not a core-shell resin and the "adduct" toughener was in fact included in the scope of the original claims 1 to 17 that restricted out from core-shell tougheners. See the Summary of Personal Interview with the Examiner, above. See the restriction requirement of U.S. Application Serial No. 09/173,146, mailed on March 03, 2000, at paragraph 6, wherein the Patent Office required a species election between the core-shell polymer, the polyhydroxyl functional crosslinker and the elastomer "adduct". Further, each of U.S. Application Serial No. 09/703,290, which became U.S. Patent no. 6,346,292, and the instant application were filed as a result of such restriction requirement; and both applications were required to cover the different species examined.

The Applicants respectfully request the reconsideration and the withdrawal of all obviousness-type double patenting rejections.

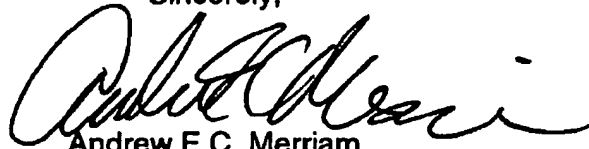
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CONCLUSION

It is submitted that the instant claims are in condition for allowance. An early and favorable action on the merits is earnestly solicited. If the Examiner has any questions, he or she is urged to contact the undersigned at the number given below.

Concurrently herewith, Applicants have filed a terminal disclaimer and the requisite fee. Please charge any additional fees to deposit account no. 18-1850.

Sincerely,



Andrew E.C. Merriam
Reg. No. 47,268

Rohm and Haas Company
100 Independence Mall West
Philadelphia, PA 19106
215-592-6758